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| APPLICATION NO. - | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------|-------------|----------------------|---------------------|------------------|
| 09/502,825 | 02/11/2000 | Kiyoshi Miyazaki | 1095.1120/JDH | 5726 |

21171 7590 01/04/2006

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/502,825 | MIYAZAKI ET AL. | |
| | Examiner | Art Unit | |
| | Harish T. Dass | 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/01/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 19-20 are cancelled.

Applicant's request for reconsideration of the finality of the rejection of the last Office action, the finality of that action is withdrawn. Applicant's arguments have been responded to in response to the claims.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 and 21 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, see claim 1 "same type of good", "mutually", "electronic market", "first type of fungible goods", "second type of fungible goods", first execution", "second execution", etc. cannot be found in originally filed specification and originally filed claims. Applicant is required to show the support for these limitations in original specification and original claims (where they can be found) or amend the claims and remove the added limitations.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5, 7-10, 12, 14, 16-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter et al (hereinafter Potter US 5,787,402) in view of Dian Hymer "Starting Out The Complete Home Buyer's Guide", Chronicle Books, San Francisco, 1997 (hereinafter Hymer).

Re. Claim 1, Potter discloses an order input unit permitting input of sell orders to sell a first type of fungible goods (currencies) in the electronic market [Abstract; Figures 15-18, 24; C1 L5-L21], and permitting the input of automatic chain purchase orders in the electronic market [Figure 15-18; C13 L20-L50; C3 L1-L11; C7 L29-L43; C9 L65 to C10 L7], an automatic chain purchase order being inputted as an order by a first party to, on condition of execution of a sell order for sale of the first type of fungible goods (GBP, USD, or CHF) [C14 L54-L55; C3 L48-L51], purchase via the electronic market a second type of fungible goods offered on the electronic market, the second type of fungible goods being a type of goods that is different from the first type of fungible goods (DEM, FRE, or USD) where a first party inputs a chain purchase order and a second party

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inputs a sell order for the first type of goods [Abstract; Figure 18; C13 L20-L50; C9 L38-L46];

an order detecting unit automatically detecting a first execution which is an execution of the inputted sell order for sale of the first type of fungible goods with respect to which the purchase chain order has been placed by the first party, where the sell order is executed by being matched with a corresponding buy order for the first type of fungible goods, and where the detected first execution is not an execution of the chain purchase order [C3 L20-L29; C14 L54-L63 – see “the system identified the nature of transaction” = detects, “allows orders to be linked to other orders” and “IF/THEN”; also see server, PC, FX Trade Server and FX applications]; and

an chain order processing unit, responsive to the detection of the first execution of the sell order for the first type of fungible goods by said order detecting unit [C3 L8-10; C14 L54-L63 - see Abstract “inputting information in response to ... the system quickly identifies the nature of the transaction ... the transaction the user desires and dynamic nature of ... transaction].

Potter does not explicitly disclose performing a second execution which is an execution of the chain purchase order for the second type of fungible goods, where the chain purchase order is executed by being matched with a corresponding sell order for sale of the second type of fungible goods. However, Hymer discloses this feature [see selected pages – chapter] where a purchasing order of a new house/property (a fungible item) is conditioned on the sale of the old house (property) to get use the equity of the old house for the down payment of the new house. It would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Potter and include performing a second execution which is an execution of the chain purchase order for the second type of fungible goods, where the chain purchase order is executed by being matched with a corresponding sell order for sale of the second type of fungible goods, as disclosed by Hymer, to allow individuals to place a buy order and a sell order conditionally linked together to use the value (money, equity, etc.) of the sell item to be used against the purchased item.

Re. Claim 3, Potter discloses display means for selectively displaying those of the chain orders which include a sell or buy order for the second type of fungible goods and which satisfy a condition for sale or purchase of the second type of fungible goods [Figure 15-18; C3 L25-L36; C7 L9-L19 – see client set-up; exchange rates are known to being tied (interlocked) to each others].

Re. Claim 5, Potter discloses price changing means for, responsive to a change in price of the first type of goods, automatically changing a price of the corresponding second type of goods of the chain order in an interlocked manner [C2 L17-L30 – see exchange rate and reflect in customer account].

Re. Claims 7-8, & 16-17 Potter discloses tax amount calculating means for calculating an amount of tax to be paid as-a result of the execution of the order [see rate calculator Figure 20, where it is well known that the tax can be calculated based on the tax rate

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using disclosed calculator]. Potter or Hymer does not explicitly disclose tax deferred exchange and calculating fee,; and notifying means for notifying parties concerned in the execution of the order of the amount of tax calculated by said tax amount calculating means and further comprising transfer means for automatically transferring a price and a tax payable as a result of the execution from one to another of accounts of parties concerned in the execution. However, it is well known to one skill in the art that taxes are calculated on taxable items (sale and trades) per IRS rules or local sale tax rules and paid regularly by consumers or tax on the sale of securities can be deferred until the end of the year. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Potter and Hymer and include deferred exchange and calculating fee, and notifying means for notifying parties concerned in the execution of the order of the amount of tax calculated by said tax amount calculating means and further comprising transfer means for automatically transferring a price and a tax payable as a result of the execution from one to another of accounts of parties concerned in the execution in order to allow the traders, an option, to pay the tax as part of trade or pay late when he/she files the tax return.

Re. Claims 9-10, 18 and 21, Claims 9-10, 18 and 21 are substantially similar to claim 1, therefore claims 9-10, 18 and 21 are rejected with same rational as claim 1.

Re. Claim 12, claim 12 is substantially similar to claim 3, therefore claim 12 is rejected with same rational as claim 3.

Re. Claim 14, claim 14 is substantially similar to claim 5, therefore claim 14 is rejected with same rational as claim 5.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Hymer, as applies to claims 1 & 10, and further in view of Braddock, III (hereinafter Braddock – US 4,412,287).

Re. Claim 2, Potter discloses chain order storing means for storing the chain order input from said chain order input means, and chain order storing means, the chain order with respect to which the automatic execution has been completed by said chain order processing means [C3 L1-L10, L42-L45; C8 L61-L67; C13 L20-L67]. Potter or Hymer does not explicitly disclose deleting. However, Braddock discloses deleting [C3 L20-L25; C6 L65-L67; C31 L9-L25] to update the file (book or record) when an order is matched and passed through execution. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Potter and Hymer and include deleting the record, as disclosed by Braddock, to update the records.

Re. Claim 11, claim 11 is substantially similar to claim 2, therefore claim 11 is rejected with same rational as claim 2.

Claims 4, 6, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Hymer, as applies to claims 1, 3, 10 & 12, and further in view of Nymeyer (US 3,581,072).

Re. Claim 4, Potter or Hymer does not explicitly disclose wherein said display means inhibits display of information about a buy / sell order for the second type of fungible goods included in the chain order when the chain order is placed, and displays the information after the chain order is executed. However, Nymeyer discloses this step [see entire document particularly, Abs; C1 L1 to C2 L38; C11 L50 to C12 L46; C30 L19-L55]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teaching of Potter and Hymer and include inhibiting displaying of information, as taught by Nymeyer, to control transfer of orders whenever there are no specific price order. Further the computer spread sheets are well known to one skill in the art where a user can selectively inhibits and/or protect any item (cell, row, column) from change or to hide the data from unauthorized user.

Re. Claim 13, claim 13 is substantially similar to claim 4, therefore claim 13 is rejected with same rational as claim 4.

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Re. Claim 6, Potter or Hymer does not explicitly disclose wherein said chain order processing means performs chain order processing in series if an order placed with respect to the second type of fungible goods to be transacted is a chain order. However, Nymeyer discloses this step [Abs; C1 L1 to C2 L38; C19 L58 to C20 L23]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teaching of Potter & Hymer and include explicitly chain order (swap) orders in series, as taught by Nymeyer, to proceed serially through entire list of orders starting from # 1.

Re. Claim 15, claim 15 is substantially similar to claim 5, therefore claim 15 is rejected with same rational as claim 6.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Regarding the Applicant's argument for withdraw of the 35 USC § 112 first paragraph, Examiner viewed the referenced pages listed on the page 8 of remarks and does not see for example fungible goods, etc. Please be specific which part of the paragraph satisfies the listed phrases stated in 35 USC § 112 first paragraph rejection. Examiner will be happy to remove 35 USC § 112 rejection, when Applicant provides what paragraph relates to what phrase for documentation purpose.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

HTD
12/21/05


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